

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF
PATENT APPEALS AND INTERFERENCES**

APPLICANTS: JEI, Dae-Gunn et al.

ART UNIT: 2612

SERIAL N0.: 10/777,807

EXAMINER: BROWN, Vernal

FILED: February 12, 2004

DATED: December 3, 2007

FOR: MOBILE TERMINAL CIRCUIT INCLUDING AN RFID TAG AND WIRELESS
IDENTIFICATION METHOD USING THE SAME

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APPELLANT'S REPLY BRIEF

Sir:

In response to the Examiner's Answer mailed on October 3, 2007, Appellants respectfully submit that based on at least the arguments provided in the Appeal Brief of June 25, 2007, Claims 1-10 and 14-19 are patentable over the applied references. The following comments are respectfully submitted in order to address statements made in the Examiner's Answer.

On page 16 in the bridge-over paragraph of the Examiner's Answer, in response to the argument that "Kuttruff fails to disclose a memory portion for storing RFID data together with mobile terminal protocol data, the Examiner asserts: "The Appellant use of the phrase 'together with' is broad and therefore the storing of the RFID data and the protocol data in the memory of the processing unit meet the limitation of a memory portion for storing RFID data together with mobile terminal protocol data." Appellants urge to the

contrary.

The Examiner is entitled to the broadest reasonable interpretation; however, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). The words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Since the Specification does not provide a clear definition of the phrase “together with,” we must now turn to the dictionary. The primary meaning of together is “In or into a single group, mass or place.” (The American Heritage College Dictionary, 3rd Ed.) The primary meaning of with is “In the company of; accompanying.” (The American Heritage College Dictionary, 3rd Ed.) Taken in the context of the claim, an artisan of ordinary skill in the art would reasonably interpret “a memory portion for storing RFID data together with mobile terminal protocol data” as “a memory portion for storing RFID data in a single group and accompanying mobile terminal protocol data,” or “a contiguous memory portion for storing RFID data in a single group and accompanying mobile terminal protocol data.” Accordingly, the Examiner is incorrect in his assertion.

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The burden of coming forward with evidence or argument shifts to the Applicant only if the Examiner’s burden is met. Id. To establish a prima facie case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also. *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the Examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)

Next, in the second full paragraph of page 16 of the Examiner’s Answer, in response to the argument that “Kutruff teaches away from a memory portion that stores RFID data together with mobile terminal data.” The Examiner further states that the claims do not recite that a single memory element stores the claimed data, merely that a memory portion stores the data. The Examiner concluded by stating it is the Examiner’s position that multiple memory elements can make up a memory portion as claimed. Appellants urge to the contrary.

As articulated above, the present application claims “a contiguous memory portion for storing RFID data and accompanying mobile terminal protocol data.” The Examiner’s claim construction is flawed. The Examiner’s conclusory statement is unaccompanied by evidence or reasoning and is entirely inadequate to

support the rejection. *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). Accordingly, the Examiner fails to meet the requirements set forth in MPEP §706.02(j).

Finally, Appellants submit that it is impermissible to use the claims as a framework from which to choose among individual references to recreate the claimed invention. *W. L. Gore Associates, Inc. v. Garlock, Inc.* 220 U.S.P.Q. 303, 312 (1983). Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783, Fed. Cir. (1992); *In re Gordon* 221 U.S.P.Q. 1125, 1127, Fed. Cir. (1984). This is a classical case where “obviousness is deceptive in hindsight.” The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

The prior art does not suggest such desirability. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art and then-accepted wisdom in the field. *W. L. Gore Associates, Inc. v. Garlock, Inc.* 220 U.S.P.Q. 303, 312 (1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” Id. Appellants have thus shown that there are missing claimed features not taught or, suggested by the cited reference, and thus Claim 1 has been erroneously rejected under 35 U.S.C. §103(a). The Examiner failed to establish a prima facie showing of obviousness.

On page 17, in the first full paragraph, the Examiner states “Appellant argues on page 13 that the reference of Ohkawa only teaches one clock as opposed to a second clock generator as recited in Claim 14, it is the Examiner’s position that the reference of Ohkawa teaches a first clock generator (61) generating a clock to the processor (8) and the memory of the processor (figure 2) and a second clock generator (62) generating a clock to the modulator (figure 3).” Appellants urge to the contrary.

A clock is an oscillator-generated signal that provides a timing reference for a transmission link. (Newton’s Telecom Dictionary, 6th Ed.) Based on that definition, the alleged clock generator (62) falls short of meeting the requirements of a clock. Clock generator (62) is not an independent clock; rather it merely

divides the frequency of the main clock and cannot have an independent frequency other than some multiple of the main clock. It is a mere slave of the main (master) clock. Accordingly, Ohkawa does not teach, disclose or fairly suggest a second clock generator as claimed in the present application.

In order for a rejection under 35 U.S.C. §103(a) to be appropriate, the claimed invention must be shown to be obvious in view of the prior art as a whole. A claim may be found to be obvious if it is first shown that all of the recitations of a claim are taught in the prior art or are suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974), cited in M.P.E.P. §2143.03.

The Examiner has failed to show that all of the recitations of independent Claims 1, 6, 7, 14, 16 and 18 are taught, disclosed or fairly suggested by either Kuttruff et al., Ohkawa, Pratt, Twitchell, Jenkins IV or Admitted Prior Art (APA), or the combination thereof. Accordingly, the Examiner has failed to make out a *prima facie* case for an obviousness rejection.

Independent Claims 1, 6, 7, 14, 16 and 18 are not rendered unpatentable by Kuttruff et al., Ohkawa, Pratt, Twitchell, Jenkins IV or Admitted Prior Art (APA), or the combination thereof. Thus, independent Claims 1, 6, 7, 14, 16 and 18 are allowable.

Accordingly, dependent Claims 2-5, 8-10, 15, 17 and 19 are allowable because of their dependence upon independent Claims 1, 6, 7, 14, 16 and 18.

Appellants respectfully request that the Board reverses such final rejection.

Respectfully submitted,



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